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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590	03/18/2004		EXAMINER	
William M Lee Jr Lee Mann Smith McWilliams Sweeney & Ohlson P O Box 2786 Chicago, IL 60690-2786			MILLS, DONALD L	
		ART UNIT	PAPER NUMBER	
		2662	4	

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/585,669	MORAN, THOMAS	
	Examiner	Art Unit	
	Donald L Mills	2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3,4,7-20,24-27,29,30 and 32-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,3,4,7-20,24-27,29,30 and 32-34 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 06 January 2004 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date . . .
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____ .

DETAILED ACTION

Claim Objections

1. Claim 18 is objected to because of the following informalities:

Regarding claim 18, "cause" should be corrected to "causing" (See claim 18, line 18.)

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 4, 7, 8, 10-17, 27, 29, 30, 32, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda.

Regarding claim 1, Beyda discloses *providing a user with an option to request a subconference with a subset of other users* (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24. See column 4, lines 33-40,) *forming a subconference between the user and the subset of other users* (The subconference call subsystem 30 establishes a first subconference call. See column 4, lines 52-54,) *and at least partially removing those users in the subconference from the main conference during the subsistence of the subconference* (Referring to Figure 2, data router 36 transmits voice data generated from the

first terminal **14** and sixth terminal **24** over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.) *Wherein each of the main conference and subconference utilize at least one of a plurality of media types selected from the group consisting of video, audio and data signals* (The users of the main conference and subconference utilize video data, voice data, and whiteboard data. See column 5, lines 3-21.) Beyda further discloses *comprising the step of enabling at least one user in the subconference to select one or more of said media types selected from said group for use in the subconference* (Referring to Figure 2, users in the subconference can utilize whiteboard data from the main conference call which is set off from subconference call whiteboard data by presenting the main conference call whiteboard data in a different color. See column 5, lines 22-26.)

Regarding claim 3, Beyda discloses *the users in the subconference are prevented from contributing to the main conference but are able to monitor communications in the main conference during the subsistence of the subconference* (Voice data generated from first terminal **14** and sixth terminal **24** are transmitted only to participants in the subconference call and voice data from the main conference call is transmitted to all terminals. See column 4, lines 57-62.)

Regarding claim 4, Beyda discloses *wherein users in the subconference can actively or passively participate in the main conference in at least one of said media types during the subsistence of the subconference* (Users in the subconference can utilize whiteboard data from the main conference call which is set off from subconference call whiteboard data by presenting the main conference call whiteboard data in a different color. See column 5, lines 22-26.)

Regarding claim 7, Beyda discloses *wherein the media types utilized in the main conference include audio and data, and wherein the subconference utilizes data signals* (Users in

the subconference can utilize video, audio, and whiteboard data from the main conference call.
See column 5, lines 22-26.)

Regarding claim 8, Beyda discloses *the users in the main conference are presented with a list of the main conference participants* (Referring to Figure 1, the conference call subsystem 26 establishes connectivity for the main conference, which is inherently tracked. See column 4, lines 33-34,) *the option to request a subconference is provided by enabling a user to select participants from the list* (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, which inherently must know the users of the network to make such a request. See column 4, lines 33-40,) *and wherein a subconference list is generated and presented to the users in the subconference* (A text message with the call set-up request is sent from the first terminal user to the sixth terminal user. See column 4, lines 42-46.)

Regarding claim 10, Beyda discloses *the users in the main conference are not presented with the subconference list during the subsistence of the subconference* (The subconference call subsystem 30 establishes the call in a manner that is transparent to the other terminals in the main conference call. See column 4, lines 54-57.)

Regarding claim 11, Beyda discloses *the main conference is formed on a conference bridge to which each of the main conference users is connected* (The main conference is routed a data router 36, or by a switch, hub, or bridge where the IP telephony terminals are connected. See column 4, lines 20-26.)

Regarding claim 12, Beyda discloses *the subconference users remaining connected to the bridge and the subconference is formed by creating a second conference on the bridge simultaneously with the main conference* (The subconference call subsystem 30 establishes the

call in a manner that is transparent to the other terminals **16, 18, 20, and 22** in the main conference call, which inherently resides on the same data router **36**. See column 4, lines 54-57.)

Regarding claim 13, Beyda discloses *the user(s) to whom the request is addressed have the option of accepting or refusing to join the subconference, and wherein such acceptance or rejection determines whether or not they remain as part of the subset* (After transmitting the request to the sixth terminal **24**, the subconference call subsystem **30** monitors for an acceptance to the call set-up request which can be accepted or rejected, which inherently determines whether the sixth terminal **24** forms a subconference with the first terminal **14**. See column 4, lines 50-52.)

Regarding claim 14, Beyda discloses *each user in the subconference is provided with the option to leave the subconference at any time during the subsistence of the subconference* (Referring to Figure 5, when a subconference call is established, at any time during the subconference call, any terminal participating in the subconference call can transfer to bi-directional transmission within the main conference call. See column 6, lines 27-30.)

Regarding claim 15, Beyda discloses *wherein users opting to leave the subconference are automatically returned to full participation in the main conference* (Any terminal which can transfer among each of its subconference calls and the main conference call. See column 6, lines 30-34.)

Regarding claim 16, Beyda discloses *wherein users in the subconference are presented with the option of requesting one or more of the other subconference users to join a nested subconference within the initial subconference* (Referring to Figures 3, 4, 5, and 7, the

subconference subsystem **30** monitor the main conference call and the first subconference call for a second request to establish a second subconference call. See column 7, lines 6-10.)

Regarding claim 17, Beyda discloses *wherein the users in the subconference are presented with the option of requesting one or more of the other subconference users to leave said initial subconference and form a new subconference without rejoining the main conference* (Referring to Figure 5, the fourth terminal **20** can establish a second subconference call from either the first subconference call or the main conference call. See column 6, lines 14-16.)

Regarding claim 27, Beyda discloses the following:

Means for generating and maintaining a list of participants in a main conference (The computer terminal of each coordinator of the combined conference call displays the names and telephone numbers of all parties in the call. See column 1, lines 66-67 and column 2, lines 1-2,)

Means for providing a participant with an option to request a subconference with a subset of other users in the list (Referring to Figure 1, first terminal **14** transmits a subconference call request **28** to the sixth terminal **24**, which inherently must know the users of the network to make such a request. See column 4, lines 33-40,)

Means for forming a list of participants in a subconference between the participant and the subset of other participants (The list of terminals participating in the subconference must inherently be stored in order for transmission of traffic to be possible,)

Means for at least partially removing those participants in the subconference from the main conference during the subsistence of the subconference (Referring to Figure 2, data router **36** transmits voice data generated from the first terminal **14** and sixth terminal **24** over the first

subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Wherein said main conference is conducted in a plurality of media including video, audio and data and wherein said means for providing a participant with an option to request a subconference includes means for enabling said participant to select one or more of said media for use during said subconference (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call, where the whiteboard data is set off from subconference call whiteboard data by presenting the main conference call whiteboard data in a different color. See column 5, lines 22-26.)

Regarding claim 29, Beyda discloses the following:

Means for forming a main conference between a plurality of users (The conference call subsystem **26** establishes connectivity for the main conference call among the first to sixth terminals. See column 4, lines 33-37,)

Means for providing a user with an option to request a subconference with a subset of other users (Referring to Figure 1, first terminal **14** transmits a subconference call request **28** to the sixth terminal **24**, which inherently must know the users of the network to make such a request. See column 4, lines 33-40,)

Means for forming a subconference between the user and the subset of other users (The subconference call subsystem **30** establishes a first subconference call. See column 4, lines 52-54,)

Means for at least partially removing those users in the subconference from the main conference during the subsistence of the subconference (Referring to Figure 2, data router **36**

transmits voice data generated from the first terminal **14** and sixth terminal **24** over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Wherein said main conference is conducted in a plurality of media including video, audio and data and wherein said means for providing a user with an option to request a subconference includes means for enabling said user to select one or more of said media for use during said subconference (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call, where the whiteboard data is set off from subconference call whiteboard data by presenting the main conference call whiteboard data in a different color. See column 5, lines 22-26.)

Regarding claim 30, Beyda discloses the following:

Means for presenting to the user an identification of participants in the conference (The computer terminal of each coordinator of the combined conference call displays the names and telephone numbers of all parties in the call. See column 1, lines 66-67 and column 2, lines 1-2,)

Means for enabling the user to generate a request for a subconference with one or more other users participating in the conference (Referring to Figure 1, first terminal **14** transmits a subconference call request **28** to the sixth terminal **24**, which inherently must know the users of the network to make such a request. See column 4, lines 33-40,)

Means for forwarding the request to a conference server to which the terminal is connected (The subconference call subsystem **30** receives the call setup request. See column 4, lines 49-50.)

Means for enabling the user to select at least one of said media types for use during said subconference (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call, where the whiteboard data is set off from subconference call whiteboard data by presenting the main conference call whiteboard data in a different color. See column 5, lines 22-26.)

Regarding claim 32, Beyda discloses *a terminal*, which comprises:

A display unit for displaying a list of conference participants (An IP telephony-enabled computer inherently has a display for listing the other terminals. See column 4, line 19,)

Input means for enabling a user to generate a subconference request with one or more of the conference participants (The IP telephony-enabled computer inherently has means for inputting a request,)

Means for forwarding this request to a conference server (Referring to Figure 1, the IP telephony-enabled computers are connected via the LAN, which is connected to the data router 36.)

Means for enabling the user to select at least one of said media types for use during said subconference (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call, where the whiteboard data is set off from subconference call whiteboard data by presenting the main conference call whiteboard data in a different color. See column 5, lines 22-26.)

Regarding claim 34, Beyda discloses *a terminal in the form of a multimedia terminal* (The communication devices are preferably Internet protocol (IP) telephony-enabled computers. See column 4, lines 18-19.)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873), hereinafter referred to as Beyda.

Regarding claim 9 as explained in the rejection statement of claim 1, Beyda discloses all the claim limitations of claim 1 (parent claim). Beyda does not disclose *wherein the users in the main conference are presented with the subconference list during the subsistence of the subconference.*

Beyda teaches that when a coordinator drops parties from the conference call to establish a subconference call, the other coordinators in the call are able to detect that some parties have been dropped (See column 2, lines 2-5.)

It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was made to allow users in the main conference to see the list of subconference users. One of ordinary skill in the art at the time the invention was made would have been motivated to do so because presenting entire user listings are well known in the art.

Regarding claim 33 as explained in the rejection statement of claim 32, Beyda discloses all the claim limitations of claim 32 (parent claim). Beyda does not disclose a *terminal in the form of a telephone handset.*

Beyda teaches a packet-based network comprising communication devices that are preferably Internet protocol (IP) telephony-enabled computers (See column 4, lines 18-19.)

It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was to implement the IP telephony-enabled computer as a telephone handset. One of ordinary skill in the art at the time the invention was made would have been motivated to do so because telephone handsets are well known in the art.

6. Claims 18-20 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda, in view of Theimer et al. (US 5,812,865), hereinafter referred to as Theimer.

Regarding claim 18, Beyda discloses a conferencing server, which comprises:

A main conference list memory unit for maintaining a list of the users connected to the server as part of a conference (The computer terminal of each coordinator of the combined conference call displays the names and telephone numbers of all parties in the call. See column 1, lines 66-67 and column 2, lines 1-2.)

Main signal processing means for receiving incoming signals of different media types selected from video, audio and data from the users, processing the signals and generating outgoing signals to the users (The users of the main conference and subconference utilize video data, voice data, and whiteboard data which is mixed by the data mixer 34 and outputted to the members of the conference. See column 5, lines 3-21)

A main control unit for controlling the main conference list memory unit and the main signal processing means (The data router 36 provides routing function for network traffic on the LAN. See column 4, lines 23-24.)

A subconference list memory unit for maintaining a list of a subset of the users (The computer terminal of each coordinator of the combined conference call displays the names and telephone numbers of all parties in the call. See column 1, lines 66-67 and column 2, lines 1-2.)

Subconference signal processing means for generating outgoing signals to the subset of users, wherein the signals generated by the subconference signal processing means include subconference signals which are not included in the signals generated by the main signal processing means and sent to users outside the subset (The subconference subsystem transmits voice data only to the participants in the first subconference call. See column 4, lines 58-63.)

A subconference control unit for controlling the subconference list memory unit and the subconference signal processing means (The subconference subsystem transmits voice data between the subset and inherently maintains a memory containing the list of users. See column 4, lines 58-63.) Beyda does not disclose the *subconference control unit being dynamically programmable causing said subconference signal processing means to generate outgoing signal streams containing a user selected combination of media types selected from the incoming signals for the users subconference*.

Theimer selectively establishing communications paths between media devices based on the context of the users. For example, user_A may set up an electronic conference with user_B. User_A may specify that a video connection is preferred, and user_A may also accept telephone, or voice only, connection (See column 27, lines 33-46.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the selective communications path method of Theimer in the system of Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a system which allows users to select media data paths between users to tailor conferences to a user's capabilities as taught by Theimer (See column 4, lines 10-13.)

Regarding claim 19, the primary reference further teaches *the main conference list memory unit and the subconference list memory unit are logical areas within a single memory unit* (The computer terminal of each coordinator of the combined conference call displays the names and telephone numbers of all parties in the call, which inherently stores the main conference list and subconference list in the same location. See column 1, lines 66-67 and column 2, lines 1-2.)

Regarding claim 20 as explained in the rejection statement of claim 18, Beyda and Theimer disclose all the claim limitations of claim 18 (parent claim). Beyda does not disclose *the functions of main signal processing means and subconference signal processing means are carried out by the same signal processing unit.*

Beyda teaches a data router 36 provides routing function for network traffic on the LAN (See column 4, lines 23-24,) and a subconference subsystem that transmits voice data only to the participants in the first subconference call (See column 4, lines 58-63.)

It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was made to integrate the processing of the data router and the subconference subsystem into one signal processing unit. One of ordinary skill in the art would have been motivated to do so because it does not produce unexpected results.

Regarding claim 24, the primary reference further teaches *wherein the main control unit includes means for forwarding the list of users in the conference to each of the users* (The list of IP telephony terminals is inherently forwarded to all of the terminals in order for the users to establish subconference calls.)

Regarding claim 25 as explained in the rejection statement of claim 18, Beyda and Theimer disclose all the claim limitations of claim 18 (parent claim). Beyda does not disclose *wherein the subconference control unit includes means for forwarding the list of the subset of user to the subset of users, and optionally to all users on the list maintained in the main conference list memory unit.*

Beyda teaches that when a coordinator drops parties from the conference call to establish a subconference call, the other coordinators in the call are able to detect that some parties have been dropped (See column 2, lines 2-5.)

It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was made to allow users in the main conference to see the list of subconference users. One of ordinary skill in the art at the time the invention was made would have been motivated to do so because presenting entire user listings was well known in the art.

Regarding claim 26, the primary reference further teaches *a call server connected to the conferencing server, and means for connecting users to the call server* (Referring to Figure 2, the packet-based communications network comprises a data router 36 and a conference call subsystem connecting multiple communication devices on a LAN. See column 4, lines 15-18.)

7. Applicant's arguments filed January 6, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument based on 35 USC § 102 regarding claims 1, 27, 29, 30, and 32; applicant claims Beyda does not teach, disclose, or otherwise make obvious allowing *users in the sub-conference to select one or more of said media types for use in the sub-conference.* However, Beyda does in fact disclose members of the sub-conference selecting whiteboard data for use by allowing the sub-conference members to select different colors of the whiteboard data (See column 5, lines 22-26.)

8. Applicant's arguments with respect to claims 18-20 and 24-26 have been considered but are moot in view of the new ground of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Mills whose telephone number is 703-305-7869. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 703-305-4744. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Donald L Mills

DLM

March 14, 2004

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